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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,384	12/20/2001	JoAnn Adele Brooks	17,055	6804

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EXAMINER
BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/037,384	BROOKS, JOANN ADELE	
	Examiner	Art Unit	
	Jenna-Leigh Befumo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) *20-34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 – 19, drawn to a disposable article, classified in class 442, subclass 123.

II. Claims 20 – 34, drawn to a method of using a disposable article, classified in class 604, subclass 289.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the disposable article can be used to clean without heating the article prior to using.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Thomas J. Connelly on July 8, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 – 19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20 – 34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 3, 10, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Brennan et al. (6,361,784).

Brennan et al. discloses a nonwoven wipe used as a pre-moistened baby wipe (abstract). The coating comprises an aqueous solution surfactant (column 3, lines 23 – 27). The surfactant can be an amphoteric or anionic surfactant (column 4, lines 23 – 27). Additionally, Brennan et al. discloses that the composition further comprises an effective amount of preservative, humectant, emollient, fragrance, and fragrance solubilizer (column 11, lines 60 – 64). The emollient functions to moisturize skin, and corresponds to the Applicant's moisturizer component (column 11, lines 66 – 67).

The limitations that the article is capable of being heated is not given patentable weight at this time since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in the patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, claims 1 – 3, 10, 12, and 13 are anticipated by Brennan et al.

7. Claims 1 – 3, 5, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pung et al. (WO 99/66793).

Pung et al. discloses a treated wipe article comprising a water-insoluble substrate and an aqueous liquid composition (page 2, paragraph 1). The water-insoluble substrate can be made from various nonwoven materials including 30/70 mixture of rayon and polyester fibers (page 5, second paragraph). The aqueous composition includes a functional ingredient, preferably an anti-microbial component made from natural essential oils such as orange, thyme, lavender, clove, or eucalyptus oil (page 8, paragraph 1). These oils would inherently be a base note aroma compound, as taught by the Applicant. The composition also comprises conditioning agents, which would inherently moisturize the skin (page 8, paragraph 4). The composition further includes anionic surfactants (page 9, paragraph 3), fragrance components, humectants, preservatives, skin soothing agents, and skin healing agents (page 16, paragraphs 2 – 3). Thus, the composition would include a fragrance component in addition to the essential oils aroma compound and humectants, skin soothing agents, or skin healing agents in addition to the conditioning agents which would qualify as a skin lubricity agent.

The limitations that the article is capable of being heated is not given patentable weight at this time since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in the patentable sense. *In re Hutchison*, 69 USPQ 138. Thus, claims 1 – 3, 5, 10, and 13 are anticipated.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brennan et al.

The features of Brennan et al. have been set forth above. Although Brennan et al. does not explicitly teach the limitations of temperature stability of the preservative, surfactants, and aroma compounds, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. essential oils, anionic surfactants, and preservatives) and in the similar production steps (i.e. mixing the components together and applying to a nonwoven wipe) used to produce the cleaning wipe. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Brennan et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Thus, claims 14 and 15 are rejected.

10. Claims 7 – 9 and 14 – 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pung et al.

The features of Pung et al. have been set forth above. Although Pung et al. does not explicitly teach the limitations of temperature stability of the preservative, surfactants, and aroma compounds, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. essential oils, anionic surfactants, and preservatives) and in the similar production steps (i.e. mixing the components together and applying to a nonwoven wipe) used to produce the cleaning wipe. The burden is

upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed limitations would obviously have been provided by the process disclosed by Pung et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Thus, claims 7 – 9 and 14 – 19 are rejected.

Claim Rejections - 35 USC § 103

11. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pung et al. in view of Skiba et al. (5,956,794).

The features of Pung et al. have been set forth above. Pung et al. discloses that various nonwoven substrates can be used as the water-insoluble substrates made from rayon and polyester fibers, however, Pung et al. fails to teach using a nonwoven substrate made from a mixture of lyocell and polyester fibers. Skiba et al. is drawn to cleansing cloths. Skiba et al. teaches it is important for the cloths to be made from blends of fibers which are not irritating and sufficiently dense to retain the cleansing solution (column 1, lines 21 – 23). Skiba et al. teaches the preferred nonwoven fabric is made from a blend of rayon and polyester fibers (column 1, lines 51 – 52). The preferred type of rayon is lyocell (column 3, lines 5 – 6). Therefore, it would have been obvious to one of ordinary skill in the art to use lyocell fibers as the preferred type of rayon fibers as taught by Skiba et al. in the nonwoven fabric taught by Pung et al. since Skiba et al. teaches that the blend of fibers is not irritating and absorbent. Thus, claims 4 and 11 are rejected.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pung et al. in view of Sun et al. (WO 01/48025 A1).

The features of Pung et al. have been set forth above. Pung et al. fails to teach using a cyclodextrin complex to entrapped the fragrance. Sun et al. is drawn to cleaning solutions. Sun et al. teaches that cyclodextrins have been used as both perfume releasers and as odor absorbents (page 2, lines 4 – 5). Further, complexing fragrances with cyclodextrins isolates the fragrance from the aqueous solvent and increase the fragrances stability and water solubility (page 3, lines 1 – 6). Thus, it would have been obvious to one of ordinary skill in the art to add cyclodextrin complexes as taught by Sun et al. to the composition taught by Pung et al. to make the fragrance more stable in the cleansing solution. Therefore, claim 6 is rejected.

13. Claims 1 – 5, 7 – 11, and 14 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skiba et al. in view of Sherry et al. (WO 01/23510).

The features of Skiba et al. have been set forth above. Skiba et al. teaches that the cleansing solution used on the wipe article includes surfactants and moisturizing agents, as well as preservatives (column 3, lines 35 – 42). Further, Skiba et al. discloses that known cleansing solutions can be employed (column 3, lines 43 – 44). However, Skiba et al. fails to teach using fragrances in the cleansing solution. Sherry et al. is drawn to cleansing solutions. Sherry et al. discloses that perfume or fragrance components are a highly preferred ingredient, which are added for their olfactory contribution (page 20, lines 15 – 18). Further, Sherry et al. teaches that usually a mixture of fragrances are added (page 20, line 15). Perfume components such as essential oils, absolutes, resinoids, resins, and/or synthetic perfumes can be used as the fragrance ingredient (page 20, lines 31 – 35). Types of essential oils include geraniol oil (page 20, line 35). Finally, Sherry et al. teaches that the less volatile, high boiling perfume ingredients provide a fresh and clean impression to the surface being cleaned. Therefore, it would have been obvious

to one of ordinary skill in the art to use a mixture of fragrance components including less volatile fragrance components such as essential oils as taught by Sherry et al. in the wipe article taught by Skiba et al. for an added olfactory contribution which provides a fresh and clean impression on the cleaned surface.

Further, the limitations of temperature stability are not explicitly taught by Skiba et al. or Sherry et al., it is reasonable to presume that said limitations would be met by the combination of the two references. Support for said presumption is found in the use of similar materials (i.e. similar components, such as essential oils, surfactants, preservatives, fragrances, and moisturizers) and in the similar production steps (i.e. mixing the cleansing solution and applying it to the nonwoven substrate) used to produce the cleansing wipe. The burden is upon the Applicant to prove otherwise. Therefore, claims 1 – 5, 7 – 11, and 14 – 19 are rejected.

14. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skiba et al. in view of Sherry et al. as applied to claim 10 above, and further in view of Sine et al. (WO 00/47183).

The features of Skiba et al. and Sherry et al. have been set forth above. Skiba et al. fails to teach the type of surfactants used in the cleansing solution. Sine et al. is drawn to a cleansing solution. Sine et al. teaches that the surfactant component can any anionic or amphoteric surfactants (page 19, paragraph 5). Therefore, it would have been obvious to one of ordinary skill in the art to use any amphoteric or anionic surfactant as taught by Sine et al. in the cleansing solution taught by Skiba et al. since Sine et al. teaches it is known to use any type of surfactant in cleansing solutions. Therefore, claims 12 and 13 are rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
September 5, 2003

CHERYL A. JUSKA
PRIMARY EXAMINER